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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/207,143	12/08/1998	DON HIDEYASU MATSUBAYASHI	36J.P170	6391

5514 7590 04/08/2003

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EXAMINER

POON, KING Y

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 04/08/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Say

# Office Action Summary

Application No.

09/207,143

Applicant(s)

MATSUBAYASHI, DON HIDEYAS

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2002 and 23 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-5, 8-22 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 4, 8-22 and 25-30 is/are allowed.
- 6) ☒ Claim(s) 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 1/23/2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09207143 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 5 recites the limitation "receives the request from the device for the executable program based on the filename" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

It is unclear whether the filename in line 6 is referring to the filename for the "executable program," or the filename for the "data" for output of the image of the quick-start guide.

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*Allowable Subject Matter*

5. Claims 3, 4, 8-22, 25-30 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter:

Independent claim 3, is directed to an interface card for output an image of a quick start guide, identifies the uniquely distinct features “a controller in the interface card receiving a request from a device for an executable program, and sending data for output of an image of a quick start guide from the interface card to the device through the connector in response to the request for the executable program, wherein the quick start guide identifies installation and configuration instructions.” The closest prior art, Furner et al. (US 5,974,474) disclose sending installation and configuration data from an interface card to a device, fails to anticipate or render the above limitations (in combination) obvious.

Independent claims 11 and 25, are directed to a method and an apparatus of outputting a quick-start guide, identify the uniquely distinct combination steps of “sending a signal to a computer system, intercept a request from the computer for a filename for an executable program, send the filename for the executable program to the computer system in response to the request for the filename, intercept a request from the computer system for the executable program, and sending the executable program to the computer system in response to the request for the executable program, wherein when the computer system executes the executable program, the executable program causes the computer system to output an image of the quick-start guide, and

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wherein the quick-start guide identifies installation and configuration instructions.” The closest prior art, Furner et al. (US 5,974,474) disclose sending installation and configuration data from an interface card to a device, fails to anticipate or render the above limitations (in combination) obvious.

7. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892

April 7, 2003

*King Yau Poon*